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Eric J. Howell

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SCHWEGMAN, LUNDBERG & WOESSNER, P.A.

P.O. BOX 2938

MINNEAPOLIS, MN 55402

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/016,302
Filing Date: October 29, 2001
Appellant(s): HOWELL ET AL.

Elena B. Dresser
Reg. 55,128
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 15 May 2008 appealing from the Office action mailed 16 November 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2002/0049617	Lencki et al.	4-2002
US 2002/0029158	Wolff et al.	3-2002
US 6,091,835	Smithies et al.	7-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[3] Claims 1-7, 9-32, and 34-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lencki et al. (United States Patent Application Publication #2002/0049617) in view of Wolff et al. (United States Patent Application Publication #2002/0029158) and further in view of Smithies et al. (United States Patent #6,091,835).

As per (currently amended) claim 1, Lencki et al. disclose a method for processing health insurance applications over a network, the method comprising: presenting a user interface to an applicant over the network (Lencki et al.; Abstract and paragraphs [0010] [0219]), the user interface including information pertaining to a health insurance plan selected by the applicant

and facilitating input of health insurance application data by the applicant (Lencki et al.; paragraphs [0010] [0084] [0085] [0114]); receiving, at a transaction facility, the health insurance application data from the applicant via the network (Lencki et al.; paragraphs [0136] [0164]).

Although Lencki et al. teaches the use of security measures including firewalls, SSL, and password authentication for users visiting the sites (Lencki et al.; paragraph [0097]), Lencki et al., fails to specifically teach assembly of user information into a single secure document for transmission to insurance carriers. Lencki et al. further fails to disclose the use of a binding electronic signature to consummate the transaction.

As evidenced by Wolff et al., the consolidation of insurance application information into a secure digital document for electronic transmission to involved parties is well known in both the insurance and e-commerce arts (Wolff et al.; paragraphs [0015] [0017] [0018]). Accordingly, Wolff et al. teach transforming the application data into a secure digital file; and transmitting the secure digital file (Wolff et al.; paragraphs [0015] [0017] [0018]) to the health insurance carrier. Additionally, Wolff et al. disclose customizing the secure document to include any information required by a specific carrier (Wolff et al.; paragraph [0018]) and upon acceptance of an insurance bid, transforming the applicant's information into an official approved insurance application (i.e., finalized application) (Wolff et al.; paragraph [0020]). Though directed to the life insurance application process, Examiner submits that the secure document assembly and transmission of insurance application data disclosed by Wolff et al. and noted above are applicable to an insurance application process as a matter of user choice. Accordingly, Wolff et

al. disclose transforming the health insurance application data into a secure digital file thereby creating a finalized health insurance application; and transmitting the secure digital file to the health insurance carrier (Wolff et al.; paragraphs [0015] [0017] [0018] [0020]).

Wolff et al. fail to disclose legally binding the policy/application by electronic signature.

However, as evidenced by Smithies et al., multi-step processes that require a party or parties to confirm transactional specifics, understanding of the material, and evidence the party's intention to be legally bound by the electronic agreement are well-known in the e-commerce art (Smithies et al.; Abstract , col. 7, lines 24-41, and col. 13, lines 14-51) in addition to providing an electronic signature (Smithies et al.; Fig. 4c and Fig. 4d). Accordingly, Smithies et al. disclose the amended limitations receiving, at a transaction facility, an electronic signature from the applicant; obtaining a confirmation from the applicant, in addition to the receiving of the electronic signature, that the applicant intends to be legally bound by the electronic signature (Smithies et al.; Abstract , col. 7, lines 24-41, col. 13, lines 14-51, and Fig. 4c and Fig. 4d).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Lencki et al. with those of Wolff et al. and Smithies et al. Such combination would have resulted in a computer-based system and method which provides for user access to the system via a user-interface (Lencki et al.; Abstract and paragraph [0010]), provides for user entry of enrollment information into the system (Lencki et al.; paragraph [0084]), enables the user to select and purchase benefits from various insurance offered health

insurance products (Lencki et al.; paragraphs [0114]), requires that the user confirms choices (Lencki et al.; paragraph [0165]), requires the user to commit to completing the transaction by committing to a dollar amount for each benefit and providing payroll information (Lencki et al.; paragraphs [0179] [0180] [0184]). Additionally, such a system and method would provide for the sending of required disclaimer language to the user in response to selection/choices (Lencki et al.; paragraph [0180]). Further, such a system and method would provide for the creation of a single Insurability Documentation File from entered and collected user data (Wolff et al.; Abstract and paragraph [0014]) and further provide for secure assembly of the document and secure transmission of the document over an encrypted or otherwise secure network to participating insurance companies (Wolff et al.; paragraphs [0015] [0018]). Additionally, such a system/method would have employed well-known techniques for producing and binding legal documents, such as insurance applications, by a multi-step process in which the affirming party is required to confirm that the affirming party (i) is in fact the identified party (ii) understands that by entering the affirming data he or she is thereby affirming or becoming legally accountable for the undertakings of the document (iii) (he or she) has adequately reviewed the document transaction and (iv) understands the undertaking of an event or the provisions within the document (Smithies et al.; Abstract). The motivation to combine the teachings of Lencki et al. with those of Wolff et al. would have been to create an Insurability Documentation File that contains information needed by insurers to evaluate a prospective insured party. Further motivation would have been to enable bidding by different insurers to increase the likelihood of the prospective insured finding an insurance policy that fits his or her needs (Wolff et al.; Abstract). The motivation to combine the additional teachings of Smithies et al. would have been

to employ well-known techniques for electronically binding contractual documents by gathering additional collateral evidence to support the contention that the electronic signature was input by the person who is claimed to be the affirming party and to generate a comprehensive transcript of record of the facts and circumstances associated with a party's action as they "sign" and "affirm" and electronic document (Smithies et al.; col. 5, lines 40-44 and col. 6, lines 61-65).

As per claim 2, Lencki et al. teaches a method further comprising providing the applicant a form of electronic payment (Lencki et al.; paragraphs [0104] [0179] [0180]).

As per claim 3, Wolff et al. teaches a method further comprising assembling the form of electronic payment into the secure digital file (Wolff et al.; paragraphs [0015] [0017] [0018]).

As per claim 4, as is evidenced by Smithies et al., obtaining of the electronic signature from the applicant comprises providing to the applicant a form of electronic signature to authenticate the applicant's intention to enter into a health insurance contract (Smithies et al.; Abstract , col. 7, lines 24-41, col. 13, lines 14-51, and Fig. 4c and Fig. 4d), is well known in the art.

As per claim 5, Smithies et al. teaches a method of further comprising assembling the form of electronic signature into the secure digital file (Smithies et al.; Abstract , col. 7, lines 24-41, col. 13, lines 14-51, and Fig. 4c and Fig. 4d).

As per claim 6, Smithies et al. teaches a method wherein the obtaining of the confirmation from the applicant that the applicant intends to be legally bound by the electronic signature comprises: requesting the applicant to type the applicant's name twice (Smithies et al.; col. 7, lines 42-57)

NOTE: Smithies enables a user choice of affirmation by typing a name; requesting the applicant to type the date (Smithies et al.; col. 14, lines 42-51 *Smithies employs a time and date stamp); providing the applicant with hyperlinks to portions of the application that have legally binding language (Smithies et al.; col. 8, lines 15-43 and col. 8, lines 60-66 *Smithies employs a transcript generator to link confirmation items to specific document statements); and requesting the applicant to check an acknowledgement box and click a button indicating the applicant's intention to be legally bound (Smithies et al.; col. 9, lines 64-67 and col. 10, lines 1-19).

As per claim 7, Lencki et al. teaches a method wherein the electronic health insurance application is in the form of any one of an hypertext markup language (HTML) page, an extensible markup language (XML) page, a dynamic HTML page, and a JavaScript (Lencki et al.; paragraphs [0276] [0277]).

As per claim 9, Lencki et al. teaches a method wherein presenting a user interface to an applicant over the network further comprises: providing a user interface to enable the applicant to enter data required in an application (Lencki et al.; paragraphs [0010] [0084] [0085] [0114]); verifying that the data entered by the applicant is appropriate for the application (Lencki et al.; paragraphs [0108] [0166] [0223]); populating an electronic application with the application data provided by the applicant (Lencki et al.; paragraphs [0084] [0085]); permitting the applicant to view the

populated application (Lencki et al.; Abstract and paragraph [0010]); and permitting the applicant to reject or approve the populated application (Lencki et al.; paragraphs [0166] [0223]).

As per claim 10, Lencki et al. teaches a method further comprising allowing the applicant to create a customer account wherein the applicant can save application data (Lencki et al.; paragraphs [0010] [0081] [0082] [0171]).

As per claim 11, Lencki et al. teaches a method wherein verifying that the data entered by the applicant is appropriate for the application further comprises analyzing the application data received from the applicant to determine (Lencki et al.; paragraphs [0108] [0166] [0223]), according to predetermined business rules (Lencki et al.; paragraph [0299]), whether the applicant has provided appropriate information (Lencki et al.; paragraphs [0108] [0166] [0223] [0299]).

As per claim 12, Lencki et al. teaches a method wherein providing a user interface to enable the applicant to enter data required in an application further comprises assisting the applicant to choose a health plan based on a plurality of factors pertaining to personal data of the applicant (Lencki et al.; paragraphs [0202] [0203]).

As per claim 13, Lencki et al. teaches a method wherein the personal data comprises any one of the number of persons covered under the health plan (Lencki et al.; paragraphs [0083] [0084] [0086]), relation between the persons and the applicant (Lencki et al.; paragraphs [0083] [0084]

[0086]), the age of the applicant (Lencki et al.; paragraphs [0138] [0140]), prior health history of the applicant (Lencki et al.; paragraph [0137]), a desired price of the plan, a preference of the applicant regarding a health insurance carrier providing the plan, and a preference of the applicant regarding the type of benefits associated with each plan (Lencki et al.; Abstract paragraphs [0116] [0117] [0118]).

NOTE: The primary function and features of Lencki et al. provide or user choice/selection of health plan and carrier choice, price of the plan, and type of benefits associated with each plan (Lencki et al.; Abstract paragraphs [0116] [0117] [0118]).

As per claim 14, Wolff et al. teaches a method wherein transforming the application data into a secure digital file comprises assembling and encrypting the application data into a preformatted electronic document (Wolff et al.; paragraphs [0015] [0016] [0017] [0018]).

As per claim 15, Wolff et al. teaches a method wherein the preformatted electronic document comprises unalterable content (Wolff et al.; paragraphs [0015] [0016]).

As per claim 16, Wolff et al. teaches a method wherein the unalterable content is characterized by a fixed language, fixed font formats, and fixed style elements (Wolff et al.; paragraph [0016]).

NOTE: Regarding claims 15 and 16, Wolff et al. teaches that the Insurability Document File is organized into "standard sections" indicating to the examiner that certain components of the

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document a standardized and unalterable (Wolff et al.; paragraph [0016]). The examiner is interpreting the standardization features of Wolff et al. to be encompassing of the applicant's unalterable content, fixed language, fixed format, and fixed style elements.

As per claim 17, Wolff et al. teaches a method wherein the preformatted digital document is an Adobe.TM. portable document format (PDF) file (Wolff et al.; paragraphs [0015] [0016]).

As per claim 18, Smithies et al. disclose teaches a method further comprising: associating a unique electronic key with the secure digital file; and storing the unique electronic key in a look-up table (Smithies et al.; col. 7, lines 58-67 and col. 8, lines 1-14).

As per claim 19, Lencki et al. teaches a method further comprising: allowing the applicant to view the secure digital file; and allowing the applicant to reject, or approve the secure digital file (Lencki et al.; paragraphs [0166] [0223]).

As per claim 20, Wolff et al. teaches a method further comprising: presenting a user interface to the health insurance carrier for processing electronic application data (Wolff et al.; paragraphs [0014] [0015] [0018]); and receiving processing updates from the health insurance carrier (Wolff et al.; paragraph [0019]).

As per claim 21, Wolff et al. teach a method wherein presenting a user interface to the health insurance carrier for processing electronic application data comprises allowing the health

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insurance carrier to search the prior history of the applicant (Wolff et al.; paragraphs [0014] [0034] [0035]).

As per claim 22, Wolff et al. teaches a method wherein presenting a user interface to the health insurance carrier for processing electronic application data comprises allowing the health insurance carrier to view and print the secure digital file (Wolff et al.; paragraph [0018]).

As per claim 23, Wolff et al. teaches a method wherein presenting a user interface to the health insurance carrier for processing electronic application data comprises: allowing the health insurance carrier to attach notes to the electronic application (Wolff et al.; paragraph [0019]); allowing the health insurance carrier to update the status of the application (Wolff et al.; paragraph [0019] [0034]); allowing the health insurance carrier to download attached data files associated with the health insurance application (Wolff et al.; paragraph [0034]); and allowing the health insurance carrier to upload a data file including processing updates (Wolff et al.; paragraph [0034]).

As per claim 24, Wolff et al. teach a method further comprising electronically communicating to the applicant processing updates made by the health insurance carrier Wolff et al.; paragraphs [0018] [0019]).

As per claim 25, Wolff et al. teaches a method wherein electronically communicating to the applicant the processing updates made by the carrier comprises creating an electronic message

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indicating the processing updates (Wolff et al.; paragraph [0034]).

As per claim 26, Wolff et al. teaches a method further comprising sending the electronic message to the applicant (Wolff et al.; paragraph [0034]).

Regarding claims 2-7 and 9-26 the obviousness and motivation to combine as discussed with regard to claim 1 above are applicable to claims 2-7 and 9-26 and are herein incorporated by reference.

As per (currently amended) claim 27, Lencki et al. disclose a system comprising: a plurality of client devices (Lencki et al.; Abstract and paragraphs [0010] [0084]); a transaction facility coupled to the plurality of client devices (Lencki et al.; Abstract and paragraphs [0010] [0084]) to: receive health insurance application data from the client devices (Lencki et al.; Abstract and paragraphs [0010] [0084]).

Although Lencki et al. teaches the use of security measures including firewalls, SSL, and password authentication for users visiting the sites (Lencki et al.; paragraph [0097]), Lencki et al., fails to specifically teach assembly of user information into a single secure document for transmission to insurance carriers. Lencki et al. further fails to disclose the use of a binding electronic signature to consummate the transaction.

As evidenced by Wolff et al., the consolidation of insurance application information into a secure digital document for electronic transmission to involved parties is well known in both the insurance and e-commerce arts (Wolff et al.; paragraphs [0015] [0017] [0018]). Accordingly, Wolff et al. teach transforming the application data into a secure digital file; and transmitting the secure digital file (Wolff et al.; paragraphs [0015] [0017] [0018]) to the health insurance carrier. Additionally, Wolff et al. disclose customizing the secure document to include any information required by a specific carrier (Wolff et al.; paragraph [0018]) and upon acceptance of an insurance bid, transforming the applicant's information into an official approved insurance application (i.e., finalized application) (Wolff et al.; paragraph [0020]). Though directed to the life insurance application process, Examiner submits that the secure document assembly and transmission of insurance application data disclosed by Wolff et al. and noted above are applicable to an insurance application process as a matter of user choice. Accordingly, Wolff et al. disclose transforming the health insurance application data into a secure digital file thereby creating a finalized health insurance application; and transmitting the secure digital file to the health insurance carrier (Wolff et al.; paragraphs [0015] [0017] [0018] [0020]).

Wolff et al. fail to disclose legally binding the policy/application by electronic signature.

However, as evidenced by Smithies et al., multi-step processes that require a party or parties to confirm transactional specifics, understanding of the material, and evidence the party's intention to be legally bound by the electronic agreement are well-known in the e-commerce art (Smithies et al.; Abstract , col. 7, lines 24-41, and col. 13, lines 14-51) in addition to providing an

electronic signature (Smithies et al.; Fig. 4c and Fig. 4d). Accordingly, Smithies et al. disclose the amended limitations receiving, at a transaction facility, an electronic signature from the applicant; obtaining a confirmation from the applicant, in addition to the receiving of the electronic signature, that the applicant intends to be legally bound by the electronic signature (Smithies et al.; Abstract , col. 7, lines 24-41, col. 13, lines 14-51, and Fig. 4c and Fig. 4d).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Lencki et al. with those of Wolff et al. and Smithies et al. Such combination would have resulted in a computer-based system and method which provides for user access to the system via a user-interface (Lencki et al.; Abstract and paragraph [0010]), provides for user entry of enrollment information into the system (Lencki et al.; paragraph [0084]), enables the user to select and purchase benefits from various insurance offered health insurance products (Lencki et al.; paragraphs [0114]), requires that the user confirms choices (Lencki et al.; paragraph [0165]), requires the user to commit to completing the transaction by committing to a dollar amount for each benefit and providing payroll information (Lencki et al.; paragraphs [0179] [0180] [0184]). Additionally, such a system and method would provide for the sending of required disclaimer language to the user in response to selection/choices (Lencki et al.; paragraph [0180]). Further, such a system and method would provide for the creation of a single Insurability Documentation File from entered and collected user data (Wolff et al.; Abstract and paragraph [0014]) and further provide for secure assembly of the document and secure transmission of the document over an encrypted or otherwise secure network to participating insurance companies (Wolff et al.; paragraphs [0015] [0018]). Additionally, such a

system/method would have employed well-known techniques for producing and binding legal documents, such as insurance applications, by a multi-step process in which the affirming party is required to confirm that the affirming party (i) is in fact the identified party (ii) understands that by entering the affirming data he or she is thereby affirming or becoming legally accountable for the undertakings of the document (iii) (he or she) has adequately reviewed the document transaction and (iv) understands the undertaking of an event or the provisions within the document (Smithies et al.; Abstract). The motivation to combine the teachings of Lencki et al. with those of Wolff et al. would have been to create an Insurability Documentation File that contains information needed by insurers to evaluate a prospective insured party. Further motivation would have been to enable bidding by different insurers to increase the likelihood of the prospective insured finding an insurance policy that fits his or her needs (Wolff et al.; Abstract). The motivation to combine the additional teachings of Smithies et al. would have been to employ well-known techniques for electronically binding contractual documents by gathering additional collateral evidence to support the contention that the electronic signature was input by the person who is claimed to be the affirming party and to generate a comprehensive transcript of record of the facts and circumstances associated with a party's action as they "sign" and "affirm" and electronic document (Smithies et al.; col. 5, lines 40-44 and col. 6, lines 61-65).

As per (currently amended) claim 28, Lencki et al. disclose an apparatus comprising: an electronic presenter to present a user interface to an applicant over the network (Lencki et al.; Abstract and paragraphs [0010] [0219]), the user interface including information pertaining to a

health insurance plan selected by the applicant and facilitating input of health insurance application data (Lencki et al.; paragraphs [0010] [0084] [0085] [0114]).

Lencki et al. fail to specifically disclose transforming the application data into a finalized application or transmitting a secure digital file. Lencki et al. further fail to disclose the use an electronic signature.

However, Wolff et al. disclose an application data processor to transform the health insurance application data into a secure digital file thereby creating a finalized health insurance application; and an electronic transmitter to transfer the secure digital file to the health insurance carrier over said network (Wolff et al.; paragraphs [0015] [0017] [0018] [0020]).

Wolff et al. fail to disclose binding by electronic signature.

However, as evidenced by Smithies et al., multi-step processes that require a party or parties to confirm transactional specifics, understanding of the material, and evidence the party's intention to be legally bound by the electronic agreement are well-known in the e-commerce art (Smithies et al.; Abstract , col. 7, lines 24-41, and col. 13, lines 14-51) in addition to providing an electronic signature (Smithies et al.; Fig. 4c and Fig. 4d). Accordingly, Smithies et al. disclose the amended limitations receiving, at a transaction facility, an electronic signature from the applicant; obtaining a confirmation from the applicant, in addition to the receiving of the

electronic signature, that the applicant intends to be legally bound by the electronic signature (Smithies et al.; Abstract , col. 7, lines 24-41, col. 13, lines 14-51, and Fig. 4c and Fig. 4d).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Lencki et al. with those of Wolff et al. and Smithies et al. Such combination would have resulted in a computer-based system and method which provides for user access to the system via a user-interface (Lencki et al.; Abstract and paragraph [0010]), provides for user entry of enrollment information into the system (Lencki et al.; paragraph [0084]), enables the user to select and purchase benefits from various insurance offered health insurance products (Lencki et al.; paragraphs [0114]), requires that the user confirms choices (Lencki et al.; paragraph [0165]), requires the user to commit to completing the transaction by committing to a dollar amount for each benefit and providing payroll information (Lencki et al.; paragraphs [0179] [0180] [0184]). Additionally, such a system and method would provide for the sending of required disclaimer language to the user in response to selection/choices (Lencki et al.; paragraph [0180]). Further, such a system and method would provide for the creation of a single Insurability Documentation File from entered and collected user data (Wolff et al.; Abstract and paragraph [0014]) and further provide for secure assembly of the document and secure transmission of the document over an encrypted or otherwise secure network to participating insurance companies (Wolff et al.; paragraphs [0015] [0018]). Additionally, such a system/method would have employed well-known techniques for producing and binding legal documents, such as insurance applications, by a multi-step process in which the affirming party is required to confirm that the affirming party (i) is in fact the identified party (ii) understands

that by entering the affirming data he or she is thereby affirming or becoming legally accountable for the undertakings of the document (iii) (he or she) has adequately reviewed the document transaction and (iv) understands the undertaking of an event or the provisions within the document (Smithies et al.; Abstract). The motivation to combine the teachings of Lencki et al with those of Wolff et al. would have been to create an Insurability Documentation File that contains information needed by insurers to evaluate a prospective insured party. Further motivation would have been to enable bidding by different insurers to increase the likelihood of the prospective insured finding an insurance policy that fits his or her needs (Wolff et al.; Abstract). The motivation to combine the additional teachings of Smithies et al. would have been to employ well-known techniques for electronically binding contractual documents by gathering additional collateral evidence to support the contention that the electronic signature was input by the person who is claimed to be the affirming party and to generate a comprehensive transcript of record of the facts and circumstances associated with a party's action as they "sign" and "affirm" and electronic document (Smithies et al.; col. 5, lines 40-44 and col. 6, lines 61-65).

As per claim 29, Lencki et al. teaches an apparatus further comprising an electronic payment module to provide the applicant a form of electronic payment (Lencki et al.; paragraphs [0104] [0179] [0180]).

As per claim 30, Smithies teaches an apparatus further comprising an electronic signature module to provide the applicant a form of electronic signature to authenticate the applicant's

intention to enter into a health insurance contract (Smithies et al.; Abstract , col. 7, lines 24-41, col. 13, lines 14-51, and Fig. 4c and Fig. 4d).

Claim 31 repeats limitations set forth in claim 6 and is therefore rejected for the reason presented above regarding claim 6.

As per claim 32, Lencki et al. teaches an apparatus wherein the electronic health insurance application is in the form of any one of a hypertext markup language (HTML) page, an extensible markup language (XML) page, a dynamic HTML page, and a JavaScript (Lencki et al.; paragraphs [0276] [0277]).

As per claim 34, Lencki et al. teaches an apparatus wherein the electronic presenter provides a user interface to enable the applicant to enter data required in an application that corresponds to a chosen health plan (Lencki et al.; paragraphs [0010] [0084] [0085] [0114]).

As per claim 35, Lencki et al. teaches an apparatus wherein the electronic presenter is further to assist the applicant to choose the health insurance plan based on a plurality of factors pertaining to personal data of the applicant (Lencki et al.; paragraphs [0202] [0203]).

As per claim 36, Lencki et al. teaches an apparatus wherein the personal data includes the number of persons covered under the health plan (Lencki et al.; paragraphs [0083] [0084] [0086]), relation between the persons and the applicant (Lencki et al.; paragraphs [0083] [0084]

[0086]), the age of the applicant (Lencki et al.; paragraphs [0138] [0140]), prior health history of the applicant (Lencki et al.; paragraph [0137]), a desired price of the plan, and a preference of the applicant regarding a health insurance carrier providing the plan (Lencki et al.; Abstract paragraphs [0116] [0117] [0118]).

NOTE: The primary function and features of Lencki et al. provide or user choice/selection of health plan and carrier choice, price of the plan, and type of benefits associated with each plan (Lencki et al.; Abstract paragraphs [0116] [0117] [0118]).

As per claim 37, Lencki et al. teaches an apparatus of claim 28 further comprising a business rule module to analyze the application data received from the applicant to determine (Lencki et al.; paragraph [0299]), according to predetermined business rules, whether the applicant has properly filled out the electronic health insurance application (Lencki et al.; paragraphs [0108] [0166] [0223] [0299]).

As per claim 38, Wolff et al. teaches an apparatus wherein the application data processor is to transform the application data into a secure digital file by assembling and encrypting the application data into a preformatted electronic document (Wolff et al.; paragraph [0018]).

As per claim 39, Wolff et al. teaches an apparatus wherein the preformatted electronic document comprises unalterable content (Wolff et al.; paragraph [0016]).

As per claim 40, Wolff et al. teaches an apparatus wherein the unalterable content is characterized by a fixed language, fixed font formats, and fixed style elements (Wolff et al.; paragraphs [0015] [0016]).

NOTE: Regarding claims 39 and 40, Wolff et al. teaches that the Insurability Document File is organized into "standard sections" indicating to the examiner that certain components of the document are standardized and unalterable (Wolff et al.; paragraph [0016]). The examiner is interpreting the standardization features of Wolff et al. to be encompassing of the applicant's unalterable content, fixed language, fixed format, and fixed style elements.

As per claim 41, Wolff et al. teaches an apparatus wherein the preformatted digital document is an Adobe.TM. portable document format (PDF) file (Wolff et al.; paragraphs [0015] [0016]).

As per claim 42, Smithies et al. teach an apparatus wherein the application data processor is to associate a unique electronic key with the secure digital file and to store the unique electronic key in a look-up table (Smithies et al.; col. 8, lines 10-14).

As per claim 43, Lencki et al. teaches an apparatus further comprising an applicant user interface to allow the applicant to view the file and to allow the applicant to approve or reject the application (Lencki et al.; paragraphs [0108] [0166] [0223]).

Wolff et al. teaches transmission of the application to the carrier (Wolff et al.; Abstract paragraphs [0015] [0017] [0018]).

As per claim 44, Wolff et al. teaches an apparatus further comprising a carrier user interface to allow the health insurance carrier to view and print the secure digital file (Wolff et al.; paragraphs [0014] [0015] [0018] [0034]).

As per claim 45, Wolff et al. teaches an apparatus further comprising a carrier user interface to allow the health insurance carrier to attach notes to the electronic application (Wolff et al.; paragraph [0019]), to allow the health insurance carrier to update the status of the application (Wolff et al.; paragraph [0019] [0034]), to allow the health insurance carrier to download attached data files associated with the health insurance application (Wolff et al.; paragraph [0034]), and to allow the health insurance carrier to upload a data file including processing updates (Wolff et al.; paragraph [0034]).

As per claim 46, Wolff et al. teaches an apparatus further comprising a carrier user interface to allow the health insurance carrier to search the prior history of the applicant (Wolff et al.; paragraphs [0014] [0034] [0035]).

As per claim 47, Wolff et al. teaches an apparatus further comprising a status notifier to notify the applicant of the status of the application (Wolff et al.; paragraph [0034]).

Regarding claims 29-32 and 34-47 the obviousness and motivation to combine as discussed with regard to claim 28 above are applicable to claims 29-32 and 34-47 and are herein incorporated by reference.

As per (currently amended) claim 48, Lencki et al. disclose a computer readable medium that provides instructions, which when executed on a processor, cause said processor to perform operations comprising: presenting a user interface to an applicant over the network (Lencki et al.; Abstract and paragraphs [0010] [0219]), the user interface including information pertaining to a health insurance plan selected by the applicant and facilitating input of health insurance application data by the applicant (Lencki et al.; paragraphs [0010] [0084] [0085] [0114]); receiving at a transaction facility, the health insurance application data from the applicant via the network (Lencki et al.; paragraphs [0136] [0164]).

However, Wolff et al. disclose an application data processor to transform the health insurance application data into a secure digital file thereby creating a finalized health insurance application; and an electronic transmitter to transfer the secure digital file to the health insurance carrier over said network (Wolff et al.; paragraphs [0015] [0017] [0018] [0020]).

Wolff et al. fail to disclose binding by electronic signature.

However, as evidenced by Smithies et al., multi-step processes that require a party or parties to confirm transactional specifics, understanding of the material, and evidence the party's intention

to be legally bound by the electronic agreement are well-known in the e-commerce art (Smithies et al.; Abstract , col. 7, lines 24-41, and col. 13, lines 14-51) in addition to providing an electronic signature (Smithies et al.; Fig. 4c and Fig. 4d). Accordingly, Smithies et al. disclose the amended limitations receiving, at a transaction facility, an electronic signature from the applicant; obtaining a confirmation from the applicant, in addition to the receiving of the electronic signature, that the applicant intends to be legally bound by the electronic signature (Smithies et al.; Abstract , col. 7, lines 24-41, col. 13, lines 14-51, and Fig. 4c and Fig. 4d).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Lencki et al. with those of Wolff et al. and Smithies et al. Such combination would have resulted in a computer-based system and method which provides for user access to the system via a user-interface (Lencki et al.; Abstract and paragraph [0010]), provides for user entry of enrollment information into the system (Lencki et al.; paragraph [0084]), enables the user to select and purchase benefits from various insurance offered health insurance products (Lencki et al.; paragraphs [0114]), requires that the user confirms choices (Lencki et al.; paragraph [0165]), requires the user to commit to completing the transaction by committing to a dollar amount for each benefit and providing payroll information (Lencki et al.; paragraphs [0179] [0180] [0184]). Additionally, such a system and method would provide for the sending of required disclaimer language to the user in response to selection/choices (Lencki et al.; paragraph [0180]). Further, such a system and method would provide for the creation of a single Insurability Documentation File from entered and collected user data (Wolff et al.; Abstract and paragraph [0014]) and further provide for secure assembly of the document and

secure transmission of the document over an encrypted or otherwise secure network to participating insurance companies (Wolff et al.; paragraphs [0015] [0018]). Additionally, such a system/method would have employed well-known techniques for producing and binding legal documents, such as insurance applications, by a multi-step process in which the affirming party is required to confirm that the affirming party (i) is in fact the identified party (ii) understands that by entering the affirming data he or she is thereby affirming or becoming legally accountable for the undertakings of the document (iii) (he or she) has adequately reviewed the document transaction and (iv) understands the undertaking of an event or the provisions within the document (Smithies et al.; Abstract). The motivation to combine the teachings of Lencki et al with those of Wolff et al. would have been to create an Insurability Documentation File that contains information needed by insurers to evaluate a prospective insured party. Further motivation would have been to enable bidding by different insurers to increase the likelihood of the prospective insured finding an insurance policy that fits his or her needs (Wolff et al.; Abstract). The motivation to combine the additional teachings of Smithies et al. would have been to employ well-known techniques for electronically binding contractual documents by gathering additional collateral evidence to support the contention that the electronic signature was input by the person who is claimed to be the affirming party and to generate a comprehensive transcript of record of the facts and circumstances associated with a party's action as they "sign" and "affirm" and electronic document (Smithies et al.; col. 5, lines 40-44 and col. 6, lines 61-65).

[OO] Newly added claim 49 differs from currently amended method claim 1 by adding the limitation of providing the applicant with hyperlinks to portions of the application that have

legally binding language to obtain a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature. As per this element, Smithies et al. disclose a transcript generator that serves to interactively display the provisions of the documents, transaction or statement to be affirmed (i.e., signed/legally binding) (Smithies et al.; col. 8, lines 60-66). Examiner considers this feature to be the functional equivalent of Applicant's use of hyperlinks.

Regarding claim 49, the obviousness and motivation to combine as discussed with regard to claim 1 above are applicable to claim 49 and are herein incorporated by reference.

[4] Claims 8 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lencki et al. Wolff et al., and Smithies et al. as applied to claims 1 and 28 above, and further in view of Peach (United States Patent Application Publication #2001/0049611).

Regarding claims 8 and 33, neither Lencki et al. nor Wolff et al. specifically teach different plans or adapting the interface to differentiate individual applicants, group applicants, and commercial applicants.

As per claim 8, Peach teaches a method wherein the health insurance plan selected by the applicant varies for individual applicants, private group applicants, and commercial group applicants (Peach; paragraph [0019]).

As per claim 33, Peach teaches an apparatus wherein the health insurance plan selected by the applicant varies for individual applicants, private group applicants, and commercial group applicants (Peach; paragraph [0019]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Lencki et al., Wolff et al., and Smithies et al. as applied to claims 1 and 28, with those of Peach. Such combination would have resulted in a system and method that expanded on the previously discussed features of Lencki and Wolff by additionally providing the user with the versatility to provide the information necessary to obtain a quote on an insurance policy for any insurable entity including an individual person, a corporation or other business entity, an association of any other like group (Peach; paragraph [0019]). The motivation to combine the teachings would have been to provide for single data entry and sharing of insurance policy application and contract data, wherein new technologies are used to configure and update the process, improving dependability and timeliness, while decreasing cost (Peach; paragraph [0008]).

Response to Remarks

Applicant's remarks filed 5 September 2007 have been fully considered but they are not persuasive. The remarks will be addressed below in the order in which they appear in the response filed 5 September 2007.

Applicant remarks that the combined teachings of Lencki et al., Wolff et al., and Smithies et al., is improper and does not describe the process defined by claim 1 of present application.

Specifically, Applicant remarks:

"Specifically, because in Lencki an on-line activity of an employee is related merely to supplemental benefits from discreet line items in conjunction with the minimum benefit package predetermined by the employer" (Lencki [0082]), Lencki teaches away from "presenting a user interface to an applicant over the network, the user interface including information pertaining to a medical plan elected by the applicant and facilitating input of application data by the applicant" and "creating a finalized health insurance application.""

In response, Examiner directs Applicant's attention to the applied teachings of Lencki et al. at paragraphs [0010][0084][0085] in view of the teachings Lencki et al. as a whole and in particular, those disclosed at paragraph [0196] and in Figures 17B-17D and 22A-22H. In the

above noted applied and supportive passages, Lencki et al. directly describes and depicts a "system for providing benefits to an employee....including at least one database comprising data representing at least one price for each of a plurality of line items within a benefit category; at least one processor for accessing the database; and a user-interface for accessing the processor to allow purchase of at least one of the line items by the employee" Lencki et al.; paragraph [0010]). Lencki et al. further disclose presentation of the interface via a network or Internet (Lencki et al.; paragraph [0196]). Further, exemplary user interfaces are depicted in Figs. 17B-17D and 22A-22H.

While Applicant remarks that the preceding step of Lencki, in which an employer broadly defines and/or selects the general benefits package for subsequent selection of coverage by the employee, teaches away from the claimed invention, Examiner maintains that the selection of benefits via the online user interface by the employee constitutes "presenting a user interface to an applicant over the network, the user interface including information pertaining to a medical plan elected by the applicant and facilitating input of application data by the applicant" under the broadest reasonable interpretation of the present claim language. In other words, Examiner fails to understand how the involvement of an initial determination of a general health plan alters the functionality of the user-interface facilitated selection of specific coverage disclosed by Lencki.

With respect to Applicant's remark directed to the above noted teachings of Lencki et al. "teaching away" from "creating a finalized health insurance application", Examiner maintains that the selection of benefits and submission of the choices for enrollment in the plan disclosed in

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the applied teachings of Lencki at paragraphs [0136] and [0164] is the equivalent of Applicant's "creating a finalized health insurance application". Examiner further notes that additional features regarding the transmission and creation of the "finalized application" are addressed by the teachings of Wolff et al.

Regarding the teachings of Wolff et al., Applicant further remarks:

"With respect to Wolff, it was explained that an Insurability Documentation File that contains the information needed by underwriters or insurers to evaluate the insurability rating of the prospective insured party (Wolff Abstract) is distinct from a health insurance application, and treating it as such would defeat the purpose of soliciting bids from insurers which is the stated purpose of Wolff (Wolff, [0013]). Thus, Wolff teaches away from "obtaining a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature" and "transforming the application data into a secure digital file thereby creating a finalized health insurance application".

Applicant further remarks:

"...the combination of Lencki and Wolff is not proper because the bidding in Wolff is useless in the context of employee selecting supplemental benefits in addition to the core package determined by the employer, and therefor it would not be obvious to one of ordinary skill in the art to have combined the teachings of Lencki with those of Wolff."

In response, Examiner notes that the bidding process described by Wolff et al. is not an element of Applicant's claimed invention nor is it relied upon by the Examiner in the rejection of the claimed invention. Examiner respectfully submits that Wolff is applied by the Examiner merely to evidence a practice well-known to both the e-commerce art at large as well as the specific insurance subset of the e-commerce art, namely, the assembly of information into a secure file for transmission to a recipient via a network. Accordingly, Examiner submits that the downstream functionality of Wolff (including the bidding process) is immaterial to the Examiner's stated reasons for rejecting the claim. Further, as both Lencki et al. and Wolff et al. are directed to the network or Internet enabled insurance application and purchase process, Examiner submits that they are analogous art and therefore maintains that the combination is proper.

Further, Examiner respectfully disagrees with Applicant statement that the assembly the "Insurability Documentation File" containing "the information needed by insurers to evaluate the insurability rating of the prospective insured party" disclosed by Wolff and acknowledged by Applicant, is distinct from an insurance application. Examiner maintains that the transmission of "information needed to underwrite" a policy from an applicant to an insurer constitutes a form of "insurance application". Examiner further disagrees with Applicant's statement that the transmission of such a document to an insurance company "teaches away" from "obtaining a confirmation from the applicant that the applicant intends to be legally bound". Examiner acknowledges that Wolff fails to disclose such transmission is not legally binding, however,

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Applicant's claim is drawn to an "intention" of the applicant. Examiner maintains that the submission of insurance application information indicates at a minimum an intention or interest on the part of the applicant to purchase insurance and thus, at a minimum indicates an "intention to be legally bound" as presently claimed by Applicant.

(10) Response to Argument

In the Appeal Brief filed 15 May 2008, Appellant makes the following arguments:

- (A) Appellant argues that the combination of Lencki, Wolff, and Smithies is not proper.
- (B) Appellant argues Wolff teaches away from the subject matter of the rejected claims.
- (C) Appellant argues that Lencki, Wolff, and Smithies in combination does not disclose each element of the rejected claims.

Examiner will address the Appellant's arguments in sequence as they appear in the Brief.

Argument (A):

In response to Appellant's first argument, Examiner notes that in many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the references nor an

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evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether "a person of ordinary skill in the art would have sufficient motivation to combine the individual [elements] forming the claimed [invention]." See *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

In support of Appellant's first argument, Appellant remarks:

"Wolff is thus aimed at facilitating the step where a consumer is choosing an insurer based on the solicited bids. Lencki, on the other hand, addresses the step where a consumer (an employer) has already made a decision regarding the selection of the insurance provider and is now allowing the employees to fine tune the selection of benefits offered by the provider."

In response,

Regarding the combination that includes Smithies, Appellant remarks:

"...Smithies is not related any particular stage of shopping or applying for any kind of insurance."

In response, Examiner respectfully disagrees with Appellant's statement and directs Appellant's attention to the teachings of Smithies at col. 41, lines 39-53. In the noted passage, Smithies

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states, "It is noted that the teachings of the present invention can be applied to a wide variety of application where the affirmation " of a document, transaction or event is necessary and for obtaining a good record of the identity and intent of the affirming party, As such, the system and method described above can be applied to application such as systems for the execution of contracts and agreements, systems for the filing of applications for insurance policies and governmental licenses.."

Appellant further argues:

"Smithies is not related to procuring insurance coverage, but is rather related to a party's affirmation of an electronic document, transaction, or event."

In response, Examiner agrees that Smithies is directed to the affirmation of an electronic document, transaction, or event. Examiner has applied Smithies to evidence the functionality noted by Appellant in meeting the limitation of the finally rejected claim. As Smithies clearly anticipates utility of the disclosed electronic affirmation system to the filing of electronic insurance applications, Examiner maintains that the combination is proper.

Argument (B):

In response to Appellant's second argument, Examiner maintains that the bidding process described by Wolff et al. is not an element of Applicant's claimed invention nor is it relied upon

by the Examiner in the rejection of the claimed invention. Examiner respectfully maintains that Wolff is applied by the Examiner merely to evidence a practice well-known to both the e-commerce art at large as well as the specific insurance subset of the e-commerce art, namely, the assembly of information into a secure file for transmission to a recipient via a network.

Accordingly, Examiner maintains that the downstream functionality of Wolff (including the bidding process) is immaterial to the Examiner's stated reasons for rejecting the claim. Further, as both Lencki et al. and Wolff et al. are directed to the network or Internet enabled insurance application and purchase process, Examiner submits that they are analogous art and therefore maintains that the combination is proper.

Arguments (C):

In response to Appellant's third argument, Appellant correctly notes that Examiner is reliant on the teachings of Wolff in addressing the limitation directed to "transforming the client data into a secure digital file". However, Examiner respectfully disagrees with Appellant's interpretation of that the assembly the "Insurability Documentation File" containing "the information needed by insurers to evaluate the insurability rating of the prospective insured party" disclosed by Wolff and acknowledged by Applicant, is distinct from an insurance application. Examiner maintains that the transmission of "information needed to underwrite" a policy from an applicant to an insurer constitutes a form of "insurance application". Examiner maintains that the secure

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transmission of the insurability document file, disclosed by Wolff et al., and noted above in the grounds of rejection is the functional equivalent of the "creating a secure document" as recited in the finally rejected claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/R. DAVID RINES/

Examiner, Art Unit 3626

Conferees:

/CLG/

Christopher Luke Gilligan S.P.E. A.U. 3626

/RWM/

Robert Morgan Primary Examiner A.U. 3626

